



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,911	04/17/2001	Gyula Hadlaczky	24601-402I	7763

24961 7590 04/28/2004

HELLER EHRMAN WHITE & MCAULIFFE LLP  
4350 LA JOLLA VILLAGE DRIVE  
7TH FLOOR  
SAN DIEGO, CA 92122-1246

EXAMINER

SHUKLA, RAM R

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/836,911

Applicant(s)

HADLACZKY ET AL.

Examiner

Ram R. Shukla

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

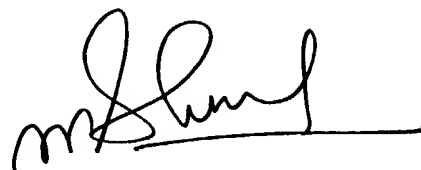
Claim(s) rejected: 23-60.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Ram R. Shukla, Ph.D.  
Primary Examiner  
Art Unit: 1632

Continuation of 5. does NOT place the application in condition for allowance because: The enablement rejection is maintained for reasons of record set forth in the previous office action of 9-23-03 and 12-18-02. It is reiterated that the specification does not provide sufficient guidance for an artisan of skill to have practiced the claimed invention without undue experimentation as discussed in the previous office actions and applicants do not provide any evidence except for arguments. Applicants' argument alone cannot take place of evidence lacking in the record (see *In re Scarbrough* 182 USPQ, (CCPA) 1979). Applicants' arguments that claim 1 is outside the purview of the rejection because generating a transgenic mammal is not required are not persuasive because the intended use of the resultant cell of claim 1 is for producing a transgenic mammal. Applicants' arguments that the case laws applied by the Examiner were not relevant are not persuasive because the case laws are relevant to unpredictable art, the issue in the instant case. Applicants' arguments that because a US Patent was issued therefore the disclosure of Wilmut et al was presumably enabled is not persuasive because the issue of the enablement of Wilmut was raised based on the questions raised in the state of the art. Applicants arguments that modifications to the methods of Schnieke et al were mere improvisations are not persuasive because applicants do not provide any evidence except for arguments that examiners' enablement analysis not correct. In summary, the rejections of record are maintained.



**RAM R. SHUKLA, PH.D.**  
**PRIMARY EXAMINER**